



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/333,159	06/14/1999	SEAN A. MCCARTHY	10147-6	3785

570 7590 11/22/2002

AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.  
ONE COMMERCE SQUARE, SUITE 2200  
2005 MARKET STREET  
PHILADELPHIA, PA 19103

EXAMINER

JIANG, DONG

ART UNIT	PAPER NUMBER
----------	--------------

1646

DATE MAILED: 11/22/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/333,159

Applicant(s)

MCCARTHY ET AL.

Examiner

Dong Jiang

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 2, 29 and 35.

Claim(s) rejected: 1-7, 12 and 24-40.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: \_\_\_\_\_

  
LORRAINE SPECTOR  
PRIMARY EXAMINER

A copy of the interview (10/15/02) summary is attached hereto.

Continuation of 2. NOTE: the amended and newly added claims raise new issues that would require further consideration and search. For example, claim 1, part e), now encompasses hybridization variants of SEQ ID NO:45 or 46, wherein the variants exhibits lipase activity, and the claim reads on any molecule has lipase activity and share some degree of sequence homology with SEQ ID NO:45 or 46. Such amendment raises new issues that would require further consideration and search. Additionally, the claims are indefinite. For example, claim 1 is directed to a nucleic acid that encodes a polypeptide, however, parts a), b) and e), encompass "a complement thereof", which does not "encode" a polypeptide. As another example, claim 47 recites two "100 nucleotide residues", and because the open language "comprises" is used, it is unclear whether the same sequence is indicated for both "100 nucleotide residues".

Continuation of 5. does NOT place the application in condition for allowance because: the amendment and additions would render claims indefinite for the reasons set forth in item 2 above. Further, claims, for example, claims 1, 3-7, 12, 26-28, 30, 31, 33, 34, 36 would remain rejected under 35 U.S.C. 112, first paragraph, for the reasons of records set forth in the previous Office Actions, paper Nos. 7 and 9, as the art generally does not acknowledges that a small portion of a large enzyme molecule, for example, 20 amino acid residues in size, would posses proper enzymatic activity. Therefore, it is more likely than not the small fragments in those claims do not posses the lipase activity.